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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/407,804 09/28/99 PELLETIER

J 241/190

EXAMINER

HM12/0904

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ART UNIT

PAPER NUMBER

1653

DATE MAILED:

09/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/407,804	PELLETIER ET AL	
	Examiner	Art Unit	
	Rita Mitra	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2001 and 08 January 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 9-14 and 33-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 9-14, 33-72 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- |   |  |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. In the response to the restriction dated 8 Jan 2001, it is noted that applicant canceled claims 1-8 and 15-32; elected Group II, claims 9, 10, and 12-14; and added new claims 33-72. In view of the foregoing, the requirement for restriction is set forth below as applicable to pending claims 9-14, and 33-72.

2. It is noted that the response of 17 July 2001 substitutes the drawings as well as presents amendment to the specification at pages 46 and Tables 1 and 3. It is also noted that claims 9, 12, 13, 33-45, 48-54, 59, 61, and 63 are amended.

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 9, 10, and 12-4, drawn to various isolated, purified, or enriched nucleic acid sequences, and recombinant vectors and cells comprising a bacteriophage 77 open reading frames 17,19, 43, 102, 104, or 182 which are SEQ ID NO: 4, 5, 6, 7, 8, and 9 respectively, classified in class 536, subclass 23.1.
- II. Claim 11, drawn to an isolated, purified, or enriched polypeptide encoded by the bacteriophage 77 open reading frames 17,19, 43, 102, 104, or 182, classified in class 530, subclass 300+.

4. In addition, both Groups I and II recite six different open reading frames where claim at least claim 9 (as well as claims 12, 13, 48, and 61) of Group I and claim 11 of Group II recite each of the open reading frames. Where Group I or II is elected, applicant is also required to elect one of SEQ ID NO: 4, 5, 6, 7, 8, or 9 because each is a different polynucleotide in Group I and each is a different polypeptide in Group II.

5. The inventions are distinct, each from the other because of the following reasons:

6. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (M.P.E.P. § 806.04, M.P.E.P. § 808.01). In the instant case the inventions of Group I and II are unrelated because each invention can be practiced independently of one another. Invention I is a polynucleotide, vector and host cells whereas the invention of Group II is a polypeptide.

7. The polynucleotide/vector/host cell is not *per se* the protein nor is the protein any of a polynucleotide or vector or host cell. The polypeptide has different physical, chemical, biological properties and functions. One cannot be directly substituted for the other.

8. Open reading frames 17,19, 43, 102, 104, or 182 which are SEQ ID NO: 4, 5, 6, 7, 8, and 9 respectively do not encode the same protein. Thus, each is separately usable in the absence any one other polynucleotide. Each is a different sequence and of a different length which makes them

physically, chemically, biologically, and structurally distinct.. It is noted that the response (pages 5-6) filed 8 Jan 2001 requests rejoinder of what are now Groups I and II above, but the commentary regarding efficiency of prosecution is unpersuasive because it is not apparent from applicant's comments how a larger search is more efficient when more classes and subclasses need to be searched. It is also noted that applicant argues no significant added burden of search. This is also unpersuasive because adding a Group II to that of Group I does in fact, enlarge the search. For example, in Class 530 subclass 350 alone, there are 5651 documents. With at least an equivalent number of foreign patent documents and an even larger number of nonpatent technical literature, this is over 16,000 documents. Absent factual data to the contrary, this constitutes an undue search burden and this does not include any additional sequence searches *per se* for which different data bases are searched for Groups I and II. Thus, the comments are unpersuasive.

9. Because these inventions are distinct for the reasons given above and since they have acquired a separate status in the art as shown by their different classification and/or divergent subject matter, and/or are separately and independently searched, restriction for examination purposes as indicated is proper.

10. A telephone call was made to Wesley Ames on or about 23 Aug 2001 to request an oral election to the above restriction requirement, but did not result in an election being made in regard to one sequence.


11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined Group I or II as well as which one sequence is to be examined even though the requirement be traversed (37 C.F.R. 1.143).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita Mitra whose telephone number is (703) 605-1211. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 703-308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-305-3014 for After Final communications.

14. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

RM  
4 Sep 2001

  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600